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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,473	05/03/2001	Troy DeFrees-Parrott	TPG 10400	6950

7590 10/22/2003

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EXAMINER	
CAPRON, AARON J	
ART UNIT	PAPER NUMBER
3714	14

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,473	DEFREES-PARROTT ET AL.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This is a response to the Amendment received on September 17, 2003, in which claims 36-45 were added and claims 1-35 were cancelled. Claims 36-45 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2003 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 36-42 and 45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-99 of copending Application No. 09/517,999. Claims 90-99 of 09/517,999 "anticipates" the present application

claims 36-42 and 45 and are not patentably distinct from the patent claims. Thus, it is apparent that the more specific 09/517,999 claims encompass the application claims. Following in the rationale in *In re Goodman* cited in the previous paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36, 40 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Vancura (U.S. Patent No. 6,033,307; hereafter "Vancura").

Referring to claims 36 and 45, Vancura discloses a base game; a wager input device; a bonus game capable of being a lottery type game (Figure 1 and 5:14-18); control circuitry to activate the bonus game; an indicating device that the player is entitled to play the bonus game; and a player input device in communication with the bonus game.

Referring to claim 40, Vancura discloses a method of operating a gaming system including the casino game is a gaming machine having electronic circuitry for generating a totally impartial, random number, the predetermined event being a number generated by the electronic circuitry (7:41-53: the bonus qualifying event being the occurrence of a random event which is unrelated to the game outcome).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Itkis (U.S. Patent No. 4,856,787).

Referring to claim 38, Vancura discloses a secondary game can be a keno game, but does not specifically disclose the graphically generating a keno drawing on the game machine. However, Itkis discloses graphically generating a keno drawing (Figure 4). One would be motivated to combine the features in order to allow users the ability to track the numbers the game being played. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the graphical representation of the keno drawing into the keno game of Vancura in order to allow users the ability to track the numbers the game being played.

Referring to claims 37 and 39, Vancura in view of Itkis disclose having a bonus/secondary game as a lottery game, but does not disclose the lottery game being a live or prerecorded lottery drawing. However, it is notoriously well known within the art of keno games that keno games have been played in a live or pre-recorded format in order to provide a player with the same experience if the player played a regular keno game. One would be motivated to provide these features into Vancura in view of Itkis in order to attract players that would normally only participate in keno games by providing normal, realistic keno game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a live into the invention of Vancura and Itkis in order to attract player that would normally only participate in regular keno games.

Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Acres et al. (U.S. Patent No. 6,319,125; hereafter "Acres").

Referring to claims 41-42, Vancura discloses a method of operating a gaming system including wide area network, but does not disclose a player tracking system. However, Acres discloses network based gaming machines that incorporate a bonus game that tracks player activity and an accounting data systems in order to verify that the bonus game and withdrawals from the gaming machines are authorized, wherein the predetermined event is when the player plays a predetermined cumulative amount of credit (Acres: 9:57-12:56). The two references are analogous since both refer to gaming machines having bonus game features. One would be motivate to combine the references in order to give Vancura a chance to monitor how often a player plays in the casino and determine incentives for the players who play more frequently.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the accounting system and player tracking of Acres into Vancura's invention in order to monitor how often a player plays in the casino and determine incentives for the players who play more frequently.

Claims 43-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Vancura in view of Luciano, Jr. et al. (U.S. Patent No. 6,050,895; "Luciano").

Referring to claims 43-44, Vancura discloses a method of operating a gaming system including wide area network and states that any suitable triggering event may qualify to access the bonus game (7:43-49), but does not specifically disclose the bonus-triggering event being based upon playing for a predetermined amount time. However, Luciano discloses that a bonus game may be triggered by a predetermined amount of time (8:66-9:15). One would be motivated to combine the references since Vancura discloses that any suitable triggering event can be used to trigger a bonus game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the bonus-triggering event of Luciano into Vancura since Vancura discloses that any suitable triggering event can be used to trigger a bonus game.

Response to Arguments

Applicant's arguments filed September 23, 2003 have been fully considered but they are not persuasive.

Applicant argues that Vancura does not provide a base game and a bonus game being a lottery game. As stated above, Vancura provides a basic game and a bonus game, wherein the bonus game is triggered based upon a triggering event. The bonus game can be a form of a lottery, such as a keno game (Figure 1 and 5:14-18). Therefore, the claimed invention fails to preclude the gaming machine of Vancura.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marnell, II (U.S. Patent No. 5,259,613) discloses a live or pre-recorded lottery drawing (2:45-59).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700